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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,526	08/05/2003	Bihua Liu	001A	6893
7590	02/17/2005		EXAMINER	
Lucy X. Yang c/o Bihua Liu 48-23 203 Street Bayside, NY 11364			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,526

Applicant(s)

LIU, BIHUA

Examiner

Dmitry Suhol

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,5,8,11 and 14 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7,9,10,12,13 and 15 is/are rejected.
- 7) ☒ Claim(s) 1 and 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 1-2 are objected to because of the following informalities:

Regarding claim 1, step e) has a period at the end thereof. It appears that it should be a comma.

Regarding claim 2, step b) reads "...that has hollow space of the desired objects...", however it appears that it should read "...that has a hollow space for the desired objects...".

Regarding claim 3, step b) starts with a capital letter, however it should be a lowercase letter. Additionally, with respect to step f), although applicants disclosure makes it clear that their masking paper has a hollow space outline, since no hollow space outline has been positively claimed applicants may want to change "the hollow space" to "a hollow space" in order to avoid confusion.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 6, 9, 12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, there is no antecedent basis for "the surface" in steps e) and f). It is unclear which surface applicants are referring to since the masking paper and canvas have multiple surfaces. Furthermore it is pointed out that applicants invention appears to reside in the control of media containing oil based paint and water mixture, in which case claim 3 does not appear to claim such control since in order for such a mixture to occur the colors need to be placed on a surface that contains water and not just near the hollow space outline. In other words the colors may be placed near the hollow space outline but must be placed on the wet surface of the masking paper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Shoalhaven Water" activity entitled "Water Art" in view of "Preschool Education" activity entitled "Oil and Water Painting" by Jane Talmas, hereafter referred to as Talmas. "Water Art" discloses a method for making a painted canvas containing most of the elements of the claims including with reference to claim 1, placing a blank canvas inside a base pan, moisturizing the blank canvas to form a film of water and depositing one or multiple flowing colors on the wetter blank canvas (read onto the step of placing

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the paper into the water/paint mixture as it accomplishes all of the claimed method steps), directing the colors to flow freely and mix with each other (read onto the step of dribbling the dilute oil paint onto water and swirling the mixture), allowing the colors to dry (described by the step of letting the art dry).

Although "Water Art" discloses most of the claim elements, the reference fails to teach moving the base pan to direct the flowing colors into various directions as required by claim 1, a mixture of oil-base pigment and oil being in the ratio from about 1:1 to about 5:1 (pigment: oil) as required by claim 1, a mixture of oil-base pigment and oil being in the ratio about 4:2 (pigment: oil) as required by claim 4 and the oil-based pigment being Enamel as required by claim 7. However, Talmas discloses an activity like that of "Water Art", which teaches that it is known to move the base pan which holds the canvas in order to mix the colors fully. Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to incorporate the step of moving the base pan to direct the flowing colors into various directions in the method of "Water Art" for the purpose of mix the colors fully as desired.

Regarding the specific ratios of pigment to oil as required by claim 1, since "Water Art" discloses general conditions of diluted oil based paint it would have been obvious to utilize the above claimed ratios of oil based pigment to oil since it has been held that where general conditions of a claim are disclosed in the prior art discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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Regarding the requirement that the oil-based pigment is Enamel (claim 7), it would have been obvious to utilize an Enamel based oil-paint in the method "Water Art" since the examiner takes official notice that Enamel based oil paints are notoriously well known and since "Water Art" does not put any limitations on the type of oil paint that may be used.

Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Water Art" and Talmas, as stated above, and further in view of Green et al '525. "Water Art" as modified by Talmas does not teach a specific type of oil that may be used with their art methods as required by claims 10 and 13, however Green discloses a device for making artistic designs which teaches the use of a mineral oil and an oil-soluble color pigment as a spreadable artistic medium (col. 10, lines 1-2). Therefore it would have been obvious to utilize a mineral oil as the oil base in the method of "Water Art" for the purpose of safety.

Allowable Subject Matter

Claims 2, 5, 8, 11 and 14 are allowed.

Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to contain all of the claimed limitations currently therein.

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Claims 6, 9, 12 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
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